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PATENT APPLICATIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

KLUG

Serial No.: 07/975,905

Filed: November 12, 1992

Atty. File No.: 2355-1-1

For: "REMOTE MULTIPLE-USER
EDITING SYSTEM AND
METHOD"

Group Art Unit: 2307

Examiner: P. Wang

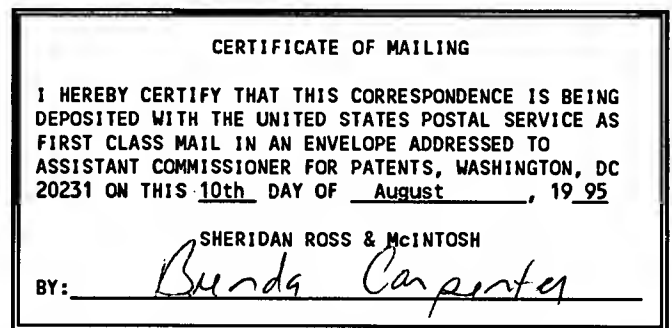
APPELLANT'S REPLY

ATTN: Board of Patent
Appeals and Interferences

BOARD OF PATENT
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GROUP 2307

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Dear Sirs:



Appellant submits this Reply to address the comments provided by the Examiner in a communication dated May 10, 1995. Enclosed herewith is a petition for a one-month extension of time, as well as a check in the amount of \$55.00 as the fee for such extension. Please charge any underpayment or credit any overpayment to Deposit Account No. 19-1970.

Appellant offers the following point-by-point to issues raised/addressed by the Examiner in the Answer:

Summary of Invention

In the above-noted communication, the Examiner took the position that the "Summary of the Invention" section of Appellant's Appeal Brief was deficient since "it also includes arguments concerning the patentability of the claims over the

prior art." Appellant has reviewed 37 C.F.R. § 1.192(c)(3) and is of the opinion that the "Summary of the Invention" section of the Appeal Brief complies with this provision. The fact that this section of the Appeal Brief may contain one or more references as to the patentability of the claims over the prior art does not mean that Appellant has failed to offer a concise explanation as required by § 1.192(c)(3). Therefore, Appellant respectfully is of the opinion that the Examiner's comments are in error and requests reconsideration of the same.

Objection Regarding Grouping of Claims

In the above-noted communication, the Examiner noted that Appellant's Appeal Brief did not include a statement that the claims do not stand and fall together. However, as noted by the Examiner, Appellant did provide a list of four claim groupings and a statement for each claim grouping that the claims identified therein did stand and fall together. Although Appellant is unsure as to how to address the Examiner's comment, Appellant respectfully notes that the appealed claims as addressed in the Appeal Brief did not stand and fall together. Instead, the appealed claims as addressed in the Appeal Brief were grouped in the above-referenced manner.

New Obviousness Rejection

MPEP § 1208.01 allows an examiner to introduce a new ground for rejection after an Appeal Brief has been filed by an appellant. MPEP § 1208.01 specifies two options for pursuing

this course of action. The first option is to reopen prosecution and § 1208.01 indicates that this course of action should be pursued by the examiner "if the reference is basic and materially better in meeting all of the claims." The second option is to merely include the new ground of rejection in the examiner's answer and § 1208.01 indicates that this option should be pursued "if the new reference anticipates some but not all of the claims or supplies a minor lack in art already relied upon."

In the above-noted communication, the Examiner withdrew the rejection of the appealed claims based upon the combination of Bly and Kaufman based upon the arguments presented by Appellant in the Appeal Brief. The Examiner then elected to reject all appealed claims under 35 U.S.C. § 103 based upon Jakobs in view of the Examiner's statements as to the state-of-the-art of personal computers. Appellant is unsure as to how to proceed procedurally since this situation is not specifically addressed in the MPEP. In the event that a new grouping of claims is required, Appellant takes the position that all appealed claims do not stand and fall together based upon the new rejection offered by the Examiner. Instead, the appealed claims are grouped as follows:

Claims 1-8, 23, and 25-28 stand and fall together.

Claims 9-11, 13-15, and 17 stand and fall together.

As to the substantive rejection made by the Examiner under § 103 based upon Jakobs, Appellant respectfully disagrees. Appellant's position is provided below.

A. No Motivation to Modify Teachings of Jakobs to Yield Appellant's Invention

As discussed in the Appeal Brief and as will be addressed in further detail below, all appealed claims require at least one and in some cases a plurality of personal computers. The Examiner takes the following position in the above-noted communication:

"Jakobs did not teach the use of personal computers as the workstations of their system, and while Jakobs's Background of the Invention may appear to actually teach away from implementing the system using personal computers, it only did up to the time of their invention (October 3, 1986). By the time of the present invention (August 23, 1989), the capabilities of personal computers had long surpassed those of the personal computers of Jakobs's time, and one of ordinary skill in the art would have recognized that contrary teachings of Jakobs's Background of the Invention were no longer applicable."

Examiner's Answer, page 4. Appellant disagrees with this position.

Initially, Appellants maintain that there is no question that Jakobs teaches away from the use of personal computers. The following excerpts from the "Background of the Invention" section of Jakobs are produced herein to illustrate this point:

Prior art single display workstation are also limited in their lack of display flexibility. Prior art workstations do not provide for both the document quality of high resolution black and white displays and the descriptiveness of multi-color graphics. Frequently in presenting information, the need arises to display color graphics that relate to displayed text. General purpose workstations are incapable of providing both displays on the same system.

Jakobs, column 1, lines 39-47.

Another limitation of prior art workstations is that they often utilize screen-displayed menu-driven software. Though screen-menu systems make operating systems easier to use, they have several characteristics that limit their performance, particularly in single display workstations where menu and work must share a single device.

Jakobs, column 1, lines 48-54.

Prior art workstations also lack an integrated real-time full-duplex communication capability. Without this capability they cannot allow dispersed users to edit a single document as a simultaneous group activity.

Jakobs, column 2, lines 9-12.

Prior art workstations also are limited in their ability to display and manipulate true graphic images. Current workstation displays are designed for ASCII-code character display. These ASCII-code based displays place characters at fixed character row and column positions and cannot arbitrarily rotate and translate characters and cannot mix these characters freely with graphics.

Jakobs, column 2, lines 31-37.

Another limitation of prior art workstations is restricted size of their field of view. The field of view of most workstation displays is limited to 23 rows for ASCII-code based systems. Since a standard hardcopy page is commonly 66 lines of text in length, the restricted field of

view complicates the composition and modification of a standard part of text. Display of only 23 lines also increases the time and effort spent in moving from page to page within a document, as numerous keystrokes are required to view the entire document.

Jakobs, column 2, lines 42-52.

Inherent in current workstations is the inability to modify displayed images by allowing the user to interact directly with the displayed image. Instead, users are required to use a mouse, lightpen, or digitizing tablet. However, these input devices require the user to split his attention between the display and the input device. The user must watch a display located in one place, while manually controlling an input device located elsewhere.

Jakobs, column 2, lines 53-61. Therefore, Jakobs more than "appears" to teach away from Appellant's invention -- it clearly teaches away from Appellant's invention.

Appellant is also unaware of any authority to support that Jakobs' teaching away from Appellant's invention, which as acknowledged by the Examiner does in fact exist, is of no

significance since Appellant's date of invention occurred after the date of Jakobs' date of invention. Stated another way, Appellant is aware of no authority which supports the proposition that a reference which expressly teaches away from a claimed invention ceases to do so when the reference is published. If this were the law, no publication could ever be characterized as teaching away from a claimed invention and be relied upon as a basis for the claimed invention not being obvious in view of this reference. However, this is not the law since it is well established that a teaching away from a claimed invention in a reference may be relied upon to support the nonobviousness of the claimed invention over this reference. See In re Fine, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988) (since the two prior art references used in the § 103 rejection by the examiner taught away from the claimed invention and/or were inconsistent therewith, the motivation for one skilled in the art to modify the teachings of these references to produce the claimed invention was judged by the Federal Circuit to be lacking such that the claimed invention was thus not obvious based upon these references). Therefore, since as acknowledged by the Examiner Jakobs expressly teaches away from Appellant's invention, there would be no motivation for one skilled in the art to modify the teachings of Jakobs in a manner which yields Appellant's invention. This is one basis to support the allowability of Appellant's invention over Jakobs.

Even if the express teaching away from Appellant's invention in Jakobs is ignored which it of course cannot be, the Examiner has offered no evidence that the invention disclosed by Jakobs could even be implemented in any personal computer in existence today. The disclosure of Jakobs is principally directed to a workstation which has "multiple displays clustered under a single transparent energized conductive surface that operates as an input device" Jakobs, column 4, lines 10-12. Jakobs characterizes one of these displays as being for "high resolution black and white capabilities", Jakobs, column 5, lines 53-55, which "is particularly suitable as a display for documents, other forms of text and other images that require a high degree of legibility but do not require multiple-tone color." Jakobs, column 5, lines 55-58. Another of these displays is characterized by Jakobs as being "used exclusively for screen display menu commands and for the image directory listings . . . which allows for retention of the advantages of menu driven systems, while avoiding work display-menu display conflicts and work display-directory display conflicts." Jakobs, column 5, one 64 through column 6, line 1. Finally, the third of these displays is characterized by Jakobs as being "for the display of high resolution color graphics and captured images." Jakobs, column 6, lines 9-10. Jakobs indicates that this "combination of three displays gives the user a combination of display functions and resolution levels to meet the requirements of most applications. For example, the viewer can

simultaneously review text and a related picture, much like viewing the text and pictures in a magazine article." Jakobs, column 6, lines 14-19.

Based upon the Examiner's failure to identify a personal computer which could implement the invention disclosed by Jakobs (e.g., multiple resolutions), Appellant submits that the Examiner has further failed to support the existence of a motivation for one skilled in the art to utilize the teachings of Jakobs in the context of a personal computer-based computer file editing system. Appellant believes that no such motivation exists. This is a further basis which supports the allowability of Appellant's invention over the disclosure of Jakobs.

As will be discussed in more detail below, the deficiencies in Jakobs in relation to Appellant's invention (such as that Jakobs fails to disclose or suggest the use of a host personal computer with a multifunctional multi-tasking processing means which both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC directly to the displays of all of the plurality of personal computers/terminals within the computer file editing system) are not overcome by a general reference to a personal computer. This is the case even if what the Examiner states to be the prior art of personal computers is true since this alone would not disclose or suggest the use of a host PC with a multifunctional multi-tasking processing means which interacts

with and controls a plurality of other PCs and/or terminals with displays in the above-noted manner. As such, since both Jakobs and the personal computers referred to by the Examiner are deficient in this respect, Appellant's invention cannot be obvious in view thereof.

B. No Teaching or Suggestion of Independent Claim 1

Claim 1 is a computer file editing system for a plurality of users at different remote locations having the following relevant subcombination of features from Claim 1 for purposes of addressing the Examiner's § 103 rejection based upon Jakobs:

- 1) the system includes at least one host PC having a multi-tasking processing means which is multifunctional, namely a host PC which both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC directly to the displays of all of the PCs within the computer file editing system; and

- 2) a plurality of users at remote locations are able to concurrently view the same portion of the computer file on their respective displays, including any edits made to the subject computer file by at least one of the users, and these edits are provided to all of the displays on a substantially real-time basis such that each user sees the edits substantially contemporaneously with the inputting of the same.

The above-noted subcombination of features is key to understanding that the obviousness rejection offered by the Examiner is improper. Appellant's invention of Claim 1 is a system which includes a plurality of interconnected PCs and/or terminals. The system of Claim 1 relies upon one of these PCs being a host computer which is interconnected with each of the other PCs and which has a multi-tasking processing means. As such, the multi-tasking processing means of the host PC allows the host PC to both coordinate the execution of file editing operations and the transfer of data, limited to the edits, from the host PC directly to the displays of all PCs within the system such that all participants see the edits substantially contemporaneously as they are made.

In the Examiner's attempted "reading" of Jakobs on Appellant's invention of Claim 1, the Examiner cited certain passages by column and line number from Jakobs which, in the Examiner's estimation, was a disclosure of certain aspects of Claim 1. However, the Examiner failed to offer any citations to Jakobs which would be tantamount to a disclosure of the above-noted subcombination of features from Claim 1. The Examiner in fact admits that this subcombination of features does not exist in Jakobs. (Examiner's Communication, page 5).

In an attempt to compensate for the lack of disclosure in Jakobs relating to the above-identified subcombination of elements from independent Claim 1, the Examiner first notes that "[a]t the time of the present invention, distributed networks

were commonly implemented using a personal computer based on the Intel 80386 microprocessor running network software (e.g., Novell NetWare 386 version 3.0), i.e., a multi-tasking personal computer acting as the host)." Examiner's Communication, pages 5-6. From this statement the Examiner surmises that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to practice the distributed conferencing and editing system of Jakobs with at least one personal computer, designated the host computer for given file editing operations, and having multi-tasking processing means for coordinating the execution of said file editing, and for coordinating the transfer of data corresponding with, and limited to, the file editing operations from the host computer to the display means of the others of the plurality of personal computers" Examiner's Communication, page 6.

Initially, the Examiner has not offered any evidence to support the Examiner's position with regard to the Intel 80386 microprocessor and its capabilities utilizing certain network software. Even if such a personal computer with these capabilities was in existence at the time of Appellant's inventive endeavors in relation to Claim 1, the combination of this PC and teachings of Jakobs (which is again improper since as acknowledged by the Examiner Jakobs expressly teaches away from such a combination) does not render Claim 1 obvious. For instance, the Examiner's position fails to identify evidence that such a PC was utilized as a host PC in a computer file

editing system including a plurality of PCs, with the host PC having a multifunctional multi-tasking processing means that both coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer of data, limited to the edits, from the multi-tasking PC directly to the displays of all of the PCs within the computer file editing system. The fact that a PC may have been in existence which would be capable of utilizing Appellant's invention of Claim 1 is not a proper basis for an obviousness rejection unless there is a suggestion or motivation to utilize such a PC in the manner set forth in Appellant's invention of Claim 1. In re Fritch, 23 U.S.P.Q. 2d (BNA) 1780, 1783-84 (Fed Cir. 1992) (although the prior art may be modified in the manner suggested by the Examiner, this does not make the modifications obvious unless the prior art suggests the desirability of the modifications); In re Mills, 16 U.S.P.Q.2d (B.N.A.) 1430, 1432 (Fed. Cir. 1990) (although prior art apparatus may be capable of being modified to run the way of the claimed apparatus, there must be some motivation or suggestion to do so in order for claimed apparatus to be obvious). Since this motivation or suggestion is lacking in this case, this is further basis for the allowability of Claim 1 over the disclosure of Jakobs.

The Examiner attempts to compensate for the lack of the foregoing by referring back to Jakobs. Specifically, the Examiner attempts to equate the disclosure in Jakobs that "changes made to the image at one workstation [are] instantly

viewed by the users at all workstations" with the element from Claim 1 relating to how the edits are being handled by the computer file editing system to provide the end result of having all participants see the changes made to a given file substantially contemporaneously with the making of such changes. In the computer file editing system of Claim 1, once again the host PC with the multifunctional multi-tasking processing means, inter alia, coordinates the transfer of data, limited to the edits, to all displays in the system. Although Appellant in no way admits that Jakobs achieves the same result as the instant invention, even assuming that Jakobs did so this would not render the way in which Appellant achieves this result as being obvious. See In re Mills, 16 U.S.P.Q.2d (B.N.A.) at 1433 (in the context of assessing an obviousness issue, "[i]t is not pertinent whether the prior art device possess the functional characteristics of the claimed invention if the reference does not describe or suggest its structure).

Jakobs provides minimal disclosure on how two or more of the workstations described therein may interconnected to accomplish the above-noted function:

Under control of the main CPU unit 16, which receives user commands from conductive surface 121 (the stylus and spatial coordinate sensing systems . . .), audio I/O unit 10 controls muting, microphone and speaker selection, and

similar audio functions for headset 101 microphone 32 and speaker 33, for example.

Communication unit 11 interfaces the main system bus 20 to digital communication unit 113. Digital communication unit 11 establishes connection with digital network 117, thereby enabling digital communications between main system bus 20 and digital network 117 through communication unit 11.

Jakobs, column 9, lines 7-22. This clearly does not disclose the manner in which Appellant's system of Claim 1 is set up with the host PC (having the multifunctional multi-tasking processing means) being interconnected with the remainder of the plurality of PCs comprising the system. The manner in which Jakobs indicates that editing is handled by its workstation in fact supports a position that when two or more workstations are interconnected, it is not in the manner contemplated by Appellant's invention with the above-noted host PC.

The editing processing at a workstation is described in column 9 wherein Jakobs indicates as follows:

Special function unit 12 performs hardware-assisted data manipulations that allow the system, under control of main CPU unit 16, in turn controlled by the user through conductive surface 121, to perform

transformations on or between any of the three display images: menu, high resolution, and still picture by causing data to flow from the respective display memory (not explicitly shown) through special function unit 12. Special function unit 12 manipulates the image data and returns it in altered form to the same or a different location in either the same or a different display memory.

Jakobs, column 9, lines 23-33. Editing operations are also discussed in column 10 wherein Jakobs indicates as follows:

The menus displayed on the display 125 are visually located under conductive surface 121. Because conductive surface 121 is transparent, the image on display 124 is visible to the user. The user is thus able to make menu selections by directing stylus 121a (see also stylus 5a of FIG. 1) over the appropriate menu legend or icon and touching stylus 121a to conductive surface 121 (the work surface of the workstation). Conductive surface 121, senses the coordinates of stylus 121a, and transmits these coordinates and the information that stylus 121a has touched

conductive surface 121 to the main CPU 16. Using a coordinate comparison look-up table technique, main CPU unit 16 interprets the coordinates as a selection of the new command represented by the new legend or icon. The selected command is then executed by main CPU 16. This menu display function is optimized for the display of menus with legends and icons in easy-to-read and attractive form, thereby facilitating user recognition and operation.

Jakobs, column 10, lines 11-29. This appears to apply to editing operations for all displays (column 10, lines 53-63; column 11, lines 17-22).

The foregoing emphasizes that editing operations go through and are controlled by the main CPU 16 of the workstation. When two or more workstations are interconnected, the editing operations should be performed on the same basis since Jakobs provides no indication to the contrary. In this case, when an edit is made at workstation No. 1, the main CPU 16 of workstation No. 1 controls the editing and the display of these edits on the relevant display of workstation No. 1 in the above-described manner. Moreover, it would appear that the main CPU 16 of workstation No. 2 receives a transmittal from the main CPU of workstation No. 1 and then causes the editing and the

displaying of these edits on the relevant display of workstation No. 2. Similarly, when an edit is made at workstation No. 2, the main CPU 16 of workstation No. 2 controls the editing and the display of these edits on the relevant display of workstation No. 2 in the above-described manner. Moreover, it would appear that the main CPU 16 of workstation No. 1 receives a transmittal from the main CPU 16 of workstation No. 1 and then causes the editing and the displaying of these edits on the relevant display of workstation No. 1. This is supported by Claim 11 which indicates that the control means of the second workstation is responsive to the control means of the first workstation. This is not Appellant's invention of Claim 1 which requires a host PC with the noted multifunctional multi-tasking processing means to provide a central control function to achieve the benefits of Appellant's invention. This is further basis for the allowability of Claim 1.

C. No Teaching or Suggestion of Independent Claim 9.

Claim 9 is a computer file editing system for a plurality of users at different remote locations having the following relevant subcombination of features from Claim 9 for purposes of addressing the Examiner's § 103 rejection based upon Jakobs:

- 1) the system includes at least one host PC having a multi-tasking processing means which is multifunctional, namely a PC which coordinates the execution of file editing operations input by at least one of the plurality of users and the transfer

of data, limited to the edits, from the multi-tasking PC directly to the displays of all of the PCs within the computer file editing system;

2) a plurality of users at remote locations are able to concurrently view the same portion of the computer file on their respective displays, including any edits made to the subject computer file by at least one of the users, and these edits are provided to all of the displays on a substantially real-time basis such that each user sees the edits substantially contemporaneously with the inputting of the same, all due to multi-tasking capabilities of the host PC; and

3) each user is able to input edits at the use's personal computer and the input devices and displays of the various personal computer directly interface with the multi-tasking processing means of the host computer.

Initially, Claim 9 is allowable for the reasons presented above with regard to Claim 1. However, Claim 9 is further allowable since it adds to the subcombination of features presented above with regard to Claim 1 a further feature that each personal computer also has an input device which directly interfaces with the multi-tasking processor of the host computer (contrasted with the Examiner's view of Claim 9 set forth on pages 6-7 of the Answer). As such, each user not only sees the edits on their respective display on a real-time basis and in accordance with the above, but each user may also input edits to the computer file during a given editing operation. This

subcombination from the computer file editing system of Claim 9 would be particularly desirable in instances where the multiplicity of remotely located users could not provide voice input to a user designated for inputting the edits. That is, the noted subcombination of features from Claim 9 would allow for the desired type of editing of a given computer file without requiring that each of the users also be in voice communication during the editing operation.

The disclosure Jakobs fails to disclose or suggest the above-note subcombination of features from Claim 9. Not only does Jakobs fail disclose or suggest that the subcombination of features discussed in relation to Claim 1 which are present in Claim 9 as well, it also fails to disclose or suggest that each user of the plurality of remote users may input edits (i.e., via the input device associated with their respective personal computer as a result of a direct interconnection with the host computer's multi-tasking processing means). Jakobs does indicate that "[t]wo or more systems can link to allow fully-interactive real time distribute conferencing and editing wherein dispersed users can work cooperatively on images viewed by all of them. For example, users at various locations can interact with and simultaneously view the same image, while cooperatively manipulating the image" Jakobs, however, also stresses that its work station also integrates voice communication capabilities. Consequently, the above quotation is by no means a disclosure that each participant in a

collaborative editing process is able to actually enter edits as required by Claim 1. This passage from Jakobs could mean, for instance, that one party makes edits in response to edits orally suggested by other participants via the integrated voice communication capabilities of the Jakobs workstation. This would of course not be a motivation or suggestion to modify the teachings of Jakobs in a manner which yields Appellant's invention of Claim 9. Moreover, the fact that a variety of alternatives could be employed to practice the teachings of Jakobs on "collaborative editing" render the position taken by the Examiner improper. See In re King, 231 U.S.P.Q. (BNA) 136, 138 (Fed. Cir. 1986) (in order for any subject matter to be inherent in a particular reference, it must necessarily flow from the teachings of the reference). Accord Ex parte Levy, 17 U.S.P.Q. 2d (BNA) 1461, 1464 (Bd. Pat. App. & Int. 1990). This is further basis for the allowability of independent Claim 9.

As noted above in relation to independent Claim 1, Jakobs provides only minimal disclosure on how two of its workstations are interconnected. Again, Claim 1 as well as Claim 9 requires a host PC with a multifunctional multi-tasking processing means for controlling the editing and transfer of data to the remainder of the PCs in the system. Not only does Jakobs fail to disclose even the structure employed in Claim 1 which is also employed in the system of Claim 9, but it also fails to disclose or suggest the structure of Claim 9 which allows for the host PC to control the editing and transfer of data in the case where

each participant in the system (e.g., at each of the PCs) may enter edits as required by Claim 9. This may be provided by the polling function described in dependent Claim 10. Jakobs provides no disclosure on this type of feature. As such, this provides a further basis for the allowability of Claim 9.

CONCLUSION

Based upon the foregoing, Appellant respectfully requests a reversal of the Examiner's § 103 rejection of all pending claims and that the above-identified patent application be passed to issuance.

Respectfully submitted,

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